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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,517	08/06/99	TUCK	ACONT.0101C2

D
EXAMINER

LM71/0821

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ART UNIT	PAPER NUMBER
2761	2

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/369,517	Applicant(s) TUCK ET AL.	
	Examiner Edward R. Cosimano	Art Unit 2761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *06 August 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 August 1999* is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
17) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows:

(A) An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

(B) The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

3.1 The oath or declaration is defective because:

A) Although it contains an address for each of the tree inventors, the given address is not identified as either the Post Office address or Residence. Hence the declaration lacks the Post Office address and Residence of each of the inventors as required by 37 CFR § 1.63(a)(3).

4. The drawings are objected to because:

A) The following errors have been noted in the drawings:

(1) The drawings lack figure 15 as disclosed at:

(a) Page 6, line 18; and

(b) Page 14, line 12,

as required by 37 CFR § 1.74.

(2) Figures 36, 42, 53, 58 & 61 use reference numbers 230, 232, 234 & 236 twice to designate different features of the invention which is forbidden by 37 CFR § 1.84(p)(4). Note pages 28, 33 & 36 which mention these numbers as figures 36, 53 & 61 are described, and pages 30 & 34 which describe figures 42 & 58 but do not mention these numbers. Note below in section (5)(B)(10).

Correction is required.

4.1 Applicant is required to submit a proposed drawing correction in response to this Office action (37 CFR § 1.121(a)(3)(ii)). However, correction of the noted defect can be deferred until the examiner allows the application.

5. The disclosure is objected to because of the following informalities:

A) The specification lacks an explicit reference to the nature of:

(1) Reference legend(s):

(a) 30 of fig. 3 at page 9;

(b) 118 of fig. 12 at page 13;

(c) 154 of fig. 15b at pages 15-16;

(d) 156 of fig. 15c at page 16;

(e) 158 of fig. 15d at page 16;

(f) 170 of fig. 19 at pages 18-19;

(g) 176 & 178 of fig. 20 at pages 19-20;

(h) 192 of fig. 26 at pages 21-22;

(i) 276 of fig. 44 at page 31;

(j) 230a & 230b of fig. 58 at page 34; and

(k) 282, 284 & 286 of fig. 60 at pages 34-35;

as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(a)(5). It is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) The following errors have been noted in the specification:

(1) The brief description of the drawings at page 6 lacks a description of figures 15a through 15e as required by 37 CFR § 1.74.

(2) At page 6, line 18, "Figures 14 to 27" should be –Figures 14, 15a to 15e and 16 to 27--.

(3) The specification lacks an explicit reference to fig. 13 as it is being described at pages 13-14 as required by 37 CFR § 1.74.

(4) At page 14, line 12, "Figures 14 to 27" should be –Figures 14, 15a to 15e and 16 to 27--.

(5) The specification lacks an explicit reference to fig. 23 as it is being described at page 21 as required by 37 CFR § 1.74.

(6) The description of figure 27 at page 22, lines 5-8, does not depict what is disclosed since the schedule tab is designated as "196" and "198". It is noted that at page 33, line 8, should the phrase "198 displays information" be –displays information 198--?

(7) From the context of the disclosure at page 28, line 19, "37" should be –36--.

(8) The specification lacks an explicit reference to fig. 36 as it is being described at page 28 as required by 37 CFR § 1.74.

(9) From the context of the disclosure at page 30, line 15, "42" should be –43--.

(10) The description of figures 36, 42, 53, 58 & 61 at pages 28, 33, 30, 34 & 36 uses reference numbers 230, 232, 234 & 236 twice to designate different features of the invention which is forbidden by 37 CFR § 1.84(p)(4). Note pages 28, 33 & 36 which mention these numbers as figures 36, 53 & 61 are described, and pages 30 & 34 which describe figures 42 & 58 but do not mention these numbers. Note above in section (4)(A)(2).

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)) & § 1.121(a)(1)-1.121(a)(6).

7. Claims 7 & 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 Applicant's inclusion of claim 7, which is directed to curtailing a transaction in the method of selling power, (note claim 1) is confusing, since it is:

A) unclear why in a method of selling the transaction should be stopped, i.e. curtailed; and

B) unclear under what conditions should the transaction be curtailed.

7.2 As per claim 9, since the buyer and seller must have some sort of knowledge of each other to ensure alt least the proper payment for the sold/bought power, the anonymous feature of claim 9 is confusing.

7.3 For the above reasons, applicant has failed to particularly point out what is regarded as the invention.

8. The following is a quotation of 35 U.S.C. § 103, which forms the basis for all obviousness rejections, set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 1-8, 10, 11 & 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Kirchmayer (2,839,962 or 3,117,221 or 3,214,699) or Starr et al (2,841,331) or Early (2,871,374) or Cohn (2,773,994 or 2,923,832) or Harder (3,027,084) or Kleinbach et al (3,229,110) or Dennison (3,359,551) or Stadlin (3,400,258) or Couvreur (3,465,164) in view of either Fraser (5,644,115) or Silverman et al (5,924,082).

8.1.1 In regard to claims 1, 2, 5, 6, 8, 10, 11 & 15, any one of Kirchmayer ('962 or '221 or '699) or Starr et al ('331) or Early ('374) or Cohn ('994 or '832) or Harder ('084) or Kleinbach et al ('110) or Dennison ('551) or Stadlin ('258) or Couvreur ('164) disclose that it is common practice in the power generation and distribution business for companies that are:

A) producing power in excess of the company's needs to sell the excess power to surrounding power companies.

B) producing less power than the company's needs to buy the excess power to surrounding power companies.

To accomplish this buying and selling of power, a company would contact nearby power producers in regard to the availability of power, the condition of the transaction, and the associated cost of the power as well as the cost of the transmission of the power. Based on the collected data, the power company would make a decision to either:

A) buy power; or

B) sell power; or

C) generate more power, if possible; or

D) curtail a transaction in progress;

based on the economics of the current period so as to provide power to it's customers at the least cost and to maximize profit. This process is equivalent to a process of auctioning power by collection bids/offers to buy or sell power and then accepting the offers.

8.1.2 However, neither Kirchmayer ('962 nor '221 nor '699) nor Starr et al ('331) nor Early ('374) nor Cohn ('994 nor '832) nor Harder ('084) nor Kleinbach et al ('110) nor Dennison ('551) nor Stadlin ('258) nor Couvreur ('164) disclose that the participants in the above process of buying and selling power are connected to a database of power generation and distribution companies that are offering to buy/sell power. Whereas in the environment of buying and selling items, either Fraser ('115) or Silverman et al ('082) disclose a system that uses a centralized collection computer to accumulate a database of offers to sell and offers to buy an item. In these systems, buyers access the central database to enter data about an offer to buy an item and to view and/or accept the offers to sell the item. Further, in these systems, sellers access the central database to enter data about offers to sell an item and view and/or accept the offers to buy the item. Where the systems of either Fraser ('115) or Silverman et al ('082) aid in the process of buying and selling item by increasing the speed of the transactions.

8.1.3 Since, the systems of either Fraser ('115) or Silverman et al ('082) would permit the power companies to accomplish the purpose of providing power to it's customers at the least cost and to maximize profit, it would have been obvious to one of ordinary kill at the time the invention was made that the trading systems of either Kirchmayer ('962 or '221 or '699) or Starr et al ('331) or Early ('374) or Cohn ('994 or '832) or Harder ('084) or Kleinbach et al ('110) or Dennison ('551) or Stadlin ('258) or Couvreur ('164) could be modified to be implemented on a computerized network so as to automate the process as taught by either Fraser ('115) or Silverman et al ('082. For as the Court has stated it is not invention to broadly replace manual activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)).

8.1.4 As per claim 3, it is noted that to aid in the presentation of the offers to buy or sell in the systems of either Kirchmayer ('962 or '221 or '699) or Starr et al ('331) or Early ('374) or

Cohn ('994 or '832) or Harder ('084) or Kleinbach et al ('110) or Dennison ('551) or Stadlin ('258) or Couvreur ('164) as modified by either Fraser ('115) or Silverman et al ('082) the offers to buy should be separated from the offers to sell so as to make it easier for the user to distinguish an offer to buy from an offer to sell.

8.1.5 As per claim 4, it is noted that in the environment of distributing power it would not be beneficial to overload the power distribution, it would have been obvious to one of ordinary skill to check the limits of the affect system before making a transaction in the systems of either Kirchmayer ('962 or '221 or '699) or Starr et al ('331) or Early ('374) or Cohn ('994 or '832) or Harder ('084) or Kleinbach et al ('110) or Dennison ('551) or Stadlin ('258) or Couvreur ('164) as modified by either Fraser ('115) or Silverman et al ('082).

9. Claims 1-15 are provisionally rejected under the judicially created doctrine of double patenting over claims 16-39 of copending Application No. 08/516,646. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

9.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the instant claims are the original version of the aloowed claims from the 08/516,646 application.

9.2 Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985);

In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9.3.1 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

9.3.2 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

11.1 The fax phone number for **UNOFFICIAL FAXES** for this group is (703) 305-0040.

11.2 The fax phone number for **OFFICIAL FAXES** for this group is either (703) 308-9051 or (703) 308-9052.

11/29/99

Edward Cosimano

Edward R. Cosimano
Primary Examiner A.U. 2761